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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,883	09/28/2001	John S. Hendricks	026880.00034	2102
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ARENT FOX LLP 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036				
EXAMINER				
LANEAU, RONALD				
ART UNIT		PAPER NUMBER		
3714				
NOTIFICATION DATE		DELIVERY MODE		
10/06/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com

IPMatters@arentfox.com

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Office Action Summary

Application No.

09/964,883

Applicant(s)

HENDRICKS, JOHN S.

Examiner

Ronald Laneau

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Paper No(s)/Mail Date: 07132/10/05132/10

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 07/10/10 has been entered.

Election/Restrictions

2. During a telephone conversation with Ms. Sheree T. Rowe on October 24, 2010 a provisional election was made with traverse to prosecute the invention of group II, claims 15-29. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-14 and 30-35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 15-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borsuk (US 5,475,399) in view of Hartrick et al (US 5,532,920).

As per claims 15, 20 and 25, Borsuk discloses a method for providing on-line accounts for purchases of electronic books via a computer (see fig. 5), comprising: storing identifications of a plurality of electronic books on a viewer in a repository accessible by a processor at an operations center (see figs. 1, 5); providing the electronic books for purchase by subscribers at a user interface functioning via the processor (see fig. 2, 40). Borsuk does not explicitly disclose an a billing system for subscribers of electronic books but Hartrick discloses initializing a plurality of home subsystems to create on-line accounts for a subscribers, including transferring subscriber information and a billing account to a billing and collection system for each of the subscribers (col. 3, lines 42-62); maintaining the on-line accounts for the subscribers in the repository (col. 5, lines 14-25); recording via the processor an indication of purchases of the electronic books in the corresponding accounts; associating via the processor an amount of each purchase with the source for the corresponding electronic book (col. 11, lines 38-60, see fig. 5); and permitting each of the subscribers to access a corresponding one of the on-line accounts for the subscriber at a user interface functioning via the processor (see fig. 11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the billing system as taught by Hartrick into the system of Borsuk because it would provide an improved method for managing the writing of a structured document so as to comply with royalty payment requirements of the documents.

As per claims 16 and 26, Borsuk's system is capable of providing on-line access to a customer service representative for the on-line accounts as claimed (see Borsuk, fig.5; e-book user can go online and will have access to customer service).

As per claims 17-19, 21-24 and 27-29, Hartrick discloses an apparatus wherein the associating step includes associating the amount with a publisher for the corresponding electronic book (col. 5, lines 14-32); wherein the providing step includes electronically communicating with a viewer for use in receiving requests to purchase the electronic books (see abs.); further including charging a subscriber account for the purchases (royalty payment)s; further including generating a bill to one of the subscribers for the purchases (col. 12, lines 33-46).

It would have been obvious to one off ordinary skill in the art at the time the invention was made to utilize the billing system as taught by Hartrick into the system of Borsuk for the same reasons previously given.

Response to Arguments

5. Applicant's arguments with respect to claims 15-29 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's previous argument regarding Borsuk are moot since there is no tracking purchases of electronic books involved in the claims. Applicant further argues that Borsuk does not disclose or suggest a method for providing on-line accounts for purchases of electronic books via a computer. Figure 5 of Borsuk actually discloses such limitations of the claimed invention. As a result, claims 15-29 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571)272-6784. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ronald Laneau/
Primary Examiner
Art Unit 3714

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